



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/596,110	06/16/2000	Kazumoto Kondo	09812.0517-00000	2719

22852 7590 05/25/2006

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

EXAMINER

BOTTS, MICHAEL K

ART UNIT	PAPER NUMBER
----------	--------------

2176

DATE MAILED: 05/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/596,110

Applicant(s)

KONDO, KAZUMOTO

Examiner

Michael K. Botts

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☒ Claim(s) 7-10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This document is a Final Office Action on the merits. This action is responsive to the following communications: Request for Continued Examination, which was filed on November 15, 2005.
2. Applicants' attention is directed to the fact that a new examiner has been assigned to this case. The Examiner's name and telephone number are provided below.
3. Claims 1-10 are currently pending in the case, with claims 1 and 4 being the independent claims.
4. Claims 1 and 4 are objected to.
5. Claims 1-6 are rejected.
6. Claims 7-10 are indicated as allowable, upon conditions stated below.

Claims Objections

7. Dependent claims 1 and 4 are objected to because of the following informalities:

Regarding independent claim 1:

The phrase "*a type of mark to emphasize a specified element*" in lines 4 and 5 should be amended as follows: "one of a plurality of said [[a]] type of mark to emphasize a specified element selected from said multiple elements."

The phrase "*wherein the single-step selection technique is defined according to a position of the specified element traced by a user and links the type of mark to the*

specified element" in lines 6-10 should be amended as follows: "wherein the type of mark single-step selection technique is determined ~~[[defined]]~~ according to a first or second position of the specified element ~~[[traced]]~~ selected by a user and links the type of mark to the specified element."

The phrase "*wherein a first position of the specified element traced by the user displays a first type of mark onto the specified element*" in lines 11 and 12 should be amended as follows: "wherein ~~[[a]]~~ the first position of the specified element traced by the user displays a first type of mark onto the specified element."

The phrase "*wherein a second position of the specified element traced by the user displays a second type of mark onto the specified element, the first type of mark being different from the second type of mark*" in lines 13-15 should be amended as follows: "wherein a second position of the specified element ~~[[traced]]~~ selected by the user displays a second type of mark onto the specified element, the first type of mark being different from the second type of mark."

Regarding independent claim 4:

The phrase "*a type of mark to emphasize a specified element*" in line 5 should be amended as follows: "one of a plurality of said ~~[[a]]~~ type of mark to emphasize a specified element selected from said multiple elements."

The phrase "*wherein the single-step selection technique is defined according to a position of the specified element traced by a user and links the type of mark to the specified element*" in lines 6-10 should be amended as follows: "wherein the type of

Art Unit: 2176

mark single-step selection technique is determined ~~[[defined]]~~ according to a first or second position of the specified element ~~[[traced]]~~ selected by a user and links the type of mark to the specified element."

The phrase "*wherein a first position of the specified element traced by the user displays a first type of mark onto the specified element*" in lines 11 and 12 should be amended as follows: "wherein ~~[[a]]~~ the first position of the specified element traced by the user displays a first type of mark onto the specified element."

The phrase "*wherein a second position of the specified element traced by the user displays a second type of mark onto the specified element, the first type of mark being different from the second type of mark*" in lines 13-15 should be amended as follows: "wherein a second position of the specified element ~~[[traced]]~~ selected by the user displays a second type of mark onto the specified element, the first type of mark being different from the second type of mark."

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claims 1, 3, 4, and 6** are rejected under 35 U.S.C. 103(a) as being unpatentable over Huffman, et al. (U.S. Patent 5,663,748, issued September 2, 1997) [hereafter "Huffman"].

Regarding **independent claim 1 (as amended)**, Huffman teaches:

An electronic book display device, comprising:

display means for displaying multiple elements forming contents of a book;

and

display control means for determining, based upon a single-step selection technique for specifying one of the multiple elements, a type of mark to emphasize a specified element;

wherein the single-step selection technique is defined according to a position of the specified element traced by a user and links the type of mark to the specified element;

wherein a first position of the specified element traced by the user displays a first type of mark onto the specified element; and

wherein a second position of the specified element traced by the user displays a second type of mark onto the specified element, the first type of mark being different from the second type of mark.

(See, Huffman, figures 1-7, and col. 3, line 64 through col. 4, line 3, teaching a display means for displaying multiple elements forming contents of book.

Huffman discloses a display control means for determining, based upon a selection technique for specifying one of said multiple elements, a type of mark to emphasize a specified element, said selection technique being defined according to a position specified by an area of the display touched by a user displaying the specified element when an optional element is specified from among said multiple elements via input means and for attaching said determined mark to said specified element in figures 19, 23, 27, and col. 17, line 62 through col. 18, line 24. The selection of elements to be marked is shown in figure 19. The selection technique is defined according to a position specified by an area of the display touched by a user displaying the specified element in figure 20.

See Huffman, col. 13, lines 44-56, teaching user selection of a portion of a page of text by use of a pointer member tracing from a beginning point to an ending point, and teaching that the selected text is "highlighted in a predetermined manner." The claimed first and second type of marks are predetermined marks and are taught by Huffman.

Huffman does not expressly teach different predetermined marks based on different specified positions. It would have been obvious to one of ordinary skill in the art at the time of the invention to have designated different predetermined markings for different locations on the page for the obvious and beneficial purpose of differentiating highlighted literary elements such as titles, summaries, text, footnotes, direct quotations, equations, etc.)

Regarding **dependent claim 3 (as amended)**, Huffman teaches:

A display method of an electronic book display device, comprising the steps of:

displaying multiple elements comprising contents of the electronic book;

and

determining, based upon a single-step selection technique for specifying on of the multiple elements, a type of mark to emphasize a specified element;

wherein a first position of the specified element traced by the user displays a first type of mark onto the specified element; and

wherein a second position of the specified element traced by the user displays a second type of mark onto the specified element, the first type of mark being different from the second type of mark.

(See, Huffman, fig. 19, 23, 27 and col. 17 line 62 – col. 18 line 24, teaching changing the display condition of a mark displayed on a specified element according to the specified operational procedure via an input means.)

Regarding **independent claim 4**:

Claim 4 incorporates substantially similar subject matter as claimed in claim 1, and is rejected along the same rationale.

Regarding **dependent claim 6**:

Claim 6 incorporates substantially similar subject matter as claimed in claim 3, and is rejected along the same rationale.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **Claims 2 and 5** are rejected under 35 U.S.C. 103(a) as being unpatentable over Huffman, et al. (U.S. Patent 5,663,748, issued September 2, 1997) [hereafter "Huffman"], in view of Hasting, et al. (U.S. Patent 5,885,012, issued March 23, 1999) [hereafter "Hastings"].

Regarding dependent claim 2, Huffman in view of Hastings teaches:

Regarding **dependent claim 2 (as amended)**, Huffman in view of Hastings teaches:

The electronic book display device according to claim 1, wherein the display control means changes the display condition of the first or second type of mark according to the number of times the specified element is specified.

(Huffman teaches the limitations of claim 1. Huffman does not expressly teach a display control means which changes the display condition of a mark according to the number of times the specified element is specified.

Hasting teaches a display control means which changes the display condition of a mark according to the number of times the specified element is specified. See, Hastings, col. 10, lines 26-42.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Huffman and Hastings to have created the claimed invention.

It would have been obvious and desirable to incorporate a means for creating different versions of the same mark such as a varying underline thickness. This repeat marking such as with multiple passes with a highlighter or with multiple passes in an underline, would have allowed the user to have more significantly marked the most important passages and less significantly marked passages of modest importance for the obvious and beneficial purpose of providing additional visual clues as to the importance of a passage.

Regarding dependent claim 5:

Claim 5 incorporates substantially similar subject matter as claimed in claim 2, and is rejected along the same rationale.

Allowable Subject Matter

10. Dependent **claims 7 and 9** are objected to as being dependent upon rejected base claims 1 and 4, respectively, but would be allowable if rewritten in independent

Art Unit: 2176

form including all of the limitations of their base claim and any intervening claims, and if the objections to their base claims are obviated.

11. The following is a statement of reasons for the indication of allowable subject matter: None of the closest prior art references, Huffman and Hasting, teach or suggest the limitation of user selection of a first or second position a specified element to assign a type of mark to emphasize the specified element. Moreover, the Examiner has not located any related art teaching or suggesting these elements.

12. Dependent **claims 8 and 10** are objected to as being dependent upon rejected base claims 1 and 4, respectively, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, and if the objections to their base claims are obviated.

13. The following is a statement of reasons for the indication of allowable subject matter: None of the closest prior art references, Huffman and Hasting, teach or suggest the limitation of user selection of a first or second position a specified element to assign a type of mark to emphasize the specified element, wherein the first type of mark is highlighting and the second type of mark is underlining. Moreover, the Examiner has not located any related art teaching or suggesting these elements.

Response to Arguments

Applicants' arguments filed October 14, 2005 have been fully considered, but they are not persuasive.

Regarding rejections of **claims 1-10**:

First: Applicants argue that that Huffman does not suggest providing a highlighting option if a lower edge part of the text is marked and providing an underlining option if a center part of the text is marked. See, RCE, dated October 14, 2005, pages 6-7.

The Examiner disagrees.

It is noted that limitations regarding highlighting or underlining based on marking edges of the text is not claimed in either claim 1 or 4.

Second: Applicants argue that Huffman fails to teach or suggest the limitations wherein a first position of the specified element traced by the used displays a first type of mark based on a one-step technique and a second position of the specified element traced by the used displays a second type of mark, also based on a one-step technique. See, RCE, dated October 14, 2005, page 7.

The Examiner disagrees.

As cited in the rejection of claims 1 and 4 above, Huffman teaches a user selection of a portion of a page of text by use of a pointer member tracing from a

beginning point to an ending point, and teaching that the selected text is "highlighted in a predetermined manner." See, Huffman, col. 13, lines 44-56. The claimed first and second type of marks are predetermined marks and are taught by Huffman. The predetermined first and second marks are not required to be the same, and for obvious and beneficial reasons discussed above, may be different. By virtue of being predetermined, selection of the text and highlighting are done in one step. The teaching of a predetermined marking, such as highlighting, also teaches other markings, such as underlining.

Third: Applicants argue as that Huang does not teach or suggest cited elements. Applicant's arguments with respect to the applicability of Huang as a prior art reference have been considered but are moot in view of the new ground(s) of rejection.

Fourth: Applicants argue that the dependent claims 2, 3, and 5-10 are allowable at least due to their direct dependence from independent claims 1 and 4.

The Examiner disagrees as to the allowability of claims 2, 3, 5, and 6, as rejected above.

The Examiner agrees as to allowability of claims 7-10 under the conditions indicated above.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS for the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael K. Botts whose telephone number is 571-272-5533. The examiner can normally be reached on Monday through Friday 8:00-4:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 571-272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

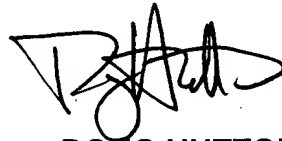
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Art Unit: 2176

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MKB/mkb

A handwritten signature in black ink, appearing to read 'DOUG HUTTON', is positioned above the printed name.

DOUG HUTTON
PRIMARY EXAMINER
TECH CENTER 2100